

REMARKS

Claims 21 to 24 are added, and claims 11 to 24 are therefore currently pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the filed Information Disclosure Statement and for acknowledging the foreign priority claim and receipt of all certified copies of the priority documents.

While copies of the foreign references should have been provided by the International Authority, to facilitate matters, courtesy copies of the previously disclosed foreign references accompanies this response.

Claims 11 to 13, 16 to 18 and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,244,226 ("Bergh").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

Also, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain

result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As to claim 11, it includes the feature “the locking device does not release the pair of wheels again until predefined critical driving state values are undershot at least for a predefined period of time”. In the Office Action at pg. 3 it is asserted that Bergh at col. 8, lines 14 to 20, discloses this feature by teaching that a critical value (17 mph) is undershot for a predefined period of time (deadband time frame), such that the predetermined period of time is the deadband time needed to undershoot the critical driving state value of 20 mph. However, the Bergh reference makes no mention whatsoever of any “deadband time frame”. This is because the “deadband” of Bergh refers to a speed range of 17 mph to 20 mph within which the steering is not reengaged despite the critical value of 20 mph being undershot.

Therefore, the Bergh device, upon undershooting the first critical driving state value of 20 mph, does not wait a predefined period of time until reengaging the steering, since it instead waits until a second critical driving state value of 17 mph is reached before the steering is reengaged. In particular, the *second critical driving state value of 17 mph may never be reached if the vehicle accelerates again, and even if it is reached, it is not certain what time would elapse between undershooting the first critical driving state value of 20 mph and undershooting the second critical driving state value of 17 mph*.

Therefore, this elapsed time is certainly not a “predefined time period” as provided for in the context of the subject matter of claim 11. Furthermore, the Bergh device, upon undershooting the second critical driving state value of 17 mph, also does not wait a predefined period of time until reengaging the steering, since the steering is immediately reengaged.

Accordingly, claim 11, as presented, is allowable, as are its dependent claims 12, 13, 16 to 18 and 20.

It is therefore respectfully requested that the anticipation rejections of claims 11 to 13, 16 to 18 and 20 be withdrawn.

Claim 19 was rejected under 35 U.S.C. § 103(a) as obvious over Bergh in view of Buelt, U.S. Pat. No. 6,105,981.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28

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U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 19 depends from claim 11, and it is therefore allowable for essentially the same reasons, since the secondary Buelt reference does not cure -- and is not asserted to cure -- the deficiencies of the Bergh reference as explained above.

Accordingly, claim 19 is allowable, and it is therefore respectfully requested that the obviousness rejection be withdrawn.

Claim 14 was rejected under 35 U.S.C. § 103(a) as obvious over Bergh.

Claim 14 depends from claim 11, and it is therefore allowable for essentially the same reasons, since the arguments regarding the asserted obviousness of the 3 to 5 second time range do not cure -- and are not asserted to cure -- the deficiencies of the Bergh reference as explained above.

Accordingly, claim 14 is allowable, and it is therefore respectfully requested that the obviousness rejection be withdrawn.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide

specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

Claims 21 to 24 do not add any new matter and are supported by the present application, including the specification. Claims 21 to 24 depend from claim 11, and they are therefore allowable for the same reasons, and for the further reasons that they recite combinations of features which are not disclosed by the applied references.

Accordingly, claims 11 to 24 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of claims 11 to 24 are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: 8/4/2009

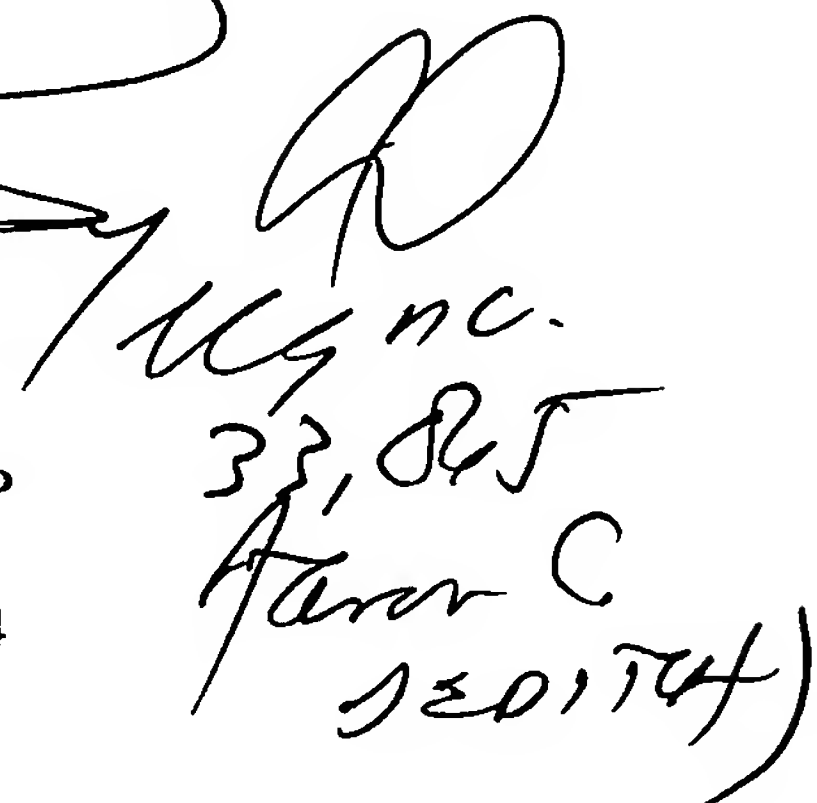
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